

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 20 January 2004.
2. Claims 1-28 are currently pending and have been examined.

### **Drawings**

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference characters not mentioned in the description: 46 in figure 5. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1, 3, 8, 10, 15, 17, 21 and 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claims 1, 8, 15 and 22 recite the limitations "the value" and "the identified products" in the fourth limitation of each claim. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 1 recites the limitation "the amount" in the last limitation of the claim. There is insufficient antecedent basis for this limitation in the claim.
8. Claims 3, 10, 17 and 24 recite the limitation "the total value". There is insufficient antecedent basis for this limitation in the claim.
9. Claims 21 and 28 recite the limitation "the amount". There is insufficient antecedent basis for this limitation in the claim.
10. Claim 22 and its dependents 23-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for claiming both an apparatus and the method steps of using the apparatus. See *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005). See also MPEP 2173.05(p)(II).

#### Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
12. Claims 22-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The *program storage system readable by a computer, tangibly embodying a program, applet or instructions executable by the computer...* of Claim 22 and its dependents is not a process, machine, manufacture, or composition of matter, or any improvement thereof. Replacing the phrase *program storage system readable by a computer, tangibly embodying a program, applet or instructions executable by the computer...* with "a computer-executable program tangibly embodied on a computer readable medium" is suggested to bring this claim into compliance with 35 U.S.C. 101 because "a computer-executable program tangibly embodied on a computer readable medium" is statutory subject matter.

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13. Claim 22 and its dependents 23-28 are rejected under 35 U.S.C. 101 because claim 22 is directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), at 1551. See also MPEP 2173.05(p)(II).

#### Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-5, 7-12, 14-19, 21-26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Valencia et al. (US 5,380,991).

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

#### Claims 1 and 22:

Valencia, as shown, discloses the following limitations:

- *discovering the benefits available to the customer* (see at least column 3, lines 24-26),
- *discovering at least one transaction product* (see at least column 3, lines 24-26),
- *identifying each transaction product for which benefits are available to the customer* (see at least column 3, lines 24-26),

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- *calculating the value of the benefit for the identified products* (see at least column 3, lines 24-26).

**Claim 1:**

Valencia, as shown, discloses the following limitation:

- *issuing an electronic coupon in the amount of the value of the benefit* (see at least column 3, lines 26-27 and line 45).

**Claim 22:**

Valencia, as shown, discloses the following limitation:

- *issuing an electronic coupon for the value of the benefit* (see at least column 3, lines 26-27 and line 45).

**Claims 2, 16 and 23:**

Valencia, as shown, discloses the following limitation:

- *calculating the value of the benefit for the identified products includes independently calculating the value of the benefit for each identified product* (see at least column 7, lines 63-66).

**Claims 3, 17 and 24:**

Valencia, as shown, discloses the following limitation:

- *calculating the value of the benefit for the identified products includes calculating the total value of the benefit for all identified products* (see at least column 8, lines 3-9).

**Claims 4 and 25:**

Valencia, as shown, discloses the following limitation:

- *discovering the benefits available to the customer includes discovering the benefits from a smart card* (see at least column 3, lines 15-19).

**Claims 5, 19 and 26:**

Valencia, as shown, discloses the following limitation:

- *identifying the customer* (see at least column 3, line 15).

**Claim 7:**

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Valencia, as shown, discloses the following limitation:

- *reducing the benefits for which the customer is eligible by the transaction product (see at least column 6, lines 40-44, specifically “and the information relating to the purchase of products...”).*

**Claim 8:**

Valencia, as shown, discloses the following limitations:

- *an extractor configured to discover, from the benefit source, the benefits available to the customer (see at least figure 5, reference 74, “reconciliation unit”),*
- *an investigator configured to discover at least one transaction product (see at least figure 5, reference 74, “reconciliation unit”),*
- *an examiner configured to identify each transaction product for which benefits are available to the customer (see at least figure 5, reference 74, “reconciliation unit”),*
- *a processing system configured to calculate the value of the benefit for the identified products (see at least figure 5, reference 74, “reconciliation unit”), and*
- *a generator configured to issue an electronic coupon for the value of the benefit (see at least figure 5, reference 62, “master reader/writer”).*

**Claim 9:**

Valencia, as shown, discloses the following limitation:

- *the processing system is further configured to independently calculate the value of the benefit for each identified product (see at least column 3, line 25).*

**Claim 10:**

Valencia, as shown, discloses the following limitation:

- *the processing system is further configured to calculate the total value of the benefit for all identified products (see at least column 3, line 26).*

**Claim 11:**

Valencia, as shown, discloses the following limitation:

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- *the benefit source includes a smart card and the extractor is configured to discover, from the smart card, the benefits available to the customer (see at least column 3, line 15).*

**Claim 12:**

Valencia, as shown, discloses the following limitation:

- *an identifier configured to identify the customer (see at least column 3, line 16).*

**Claim 14:**

Valencia, as shown, discloses the following limitation:

- *a decrementer configured to reduce the benefits for which the customer is eligible by the amount of the electronic coupon (see at least column 3, lines 28-29).*

**Claim 15:**

Valencia, as shown, discloses the following limitations:

- *means for discovering, from the benefit source, the benefits available to the customer (see at least figure 5, reference 74, "reconciliation unit"),*
- *means for discovering at least one transaction product (see at least figure 5, reference 74, "reconciliation unit"),*
- *means for identifying each transaction product for which benefits are available to the customer (see at least figure 5, reference 74, "reconciliation unit"),*
- *means for calculating the value of the benefit for the identified products (see at least figure 5, reference 74, "reconciliation unit"), and*
- *means for issuing an electronic coupon for the value of the benefit (see at least figure 5, reference 62, "master reader/writer").*

**Claim 18:**

Valencia, as shown, discloses the following limitations:

- *the benefit source includes a smart card (see at least column 3, line 15),*
- *discovering, from the benefit source, the benefits available to the customer includes means for discovering, from the smart card, the benefits available to the customer (see at least column 3, line 15).*

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**Claim 21:**

Valencia, as shown, discloses the following limitation:

- *reducing the benefits for which the customer is eligible by the amount of the electronic coupon* (see at least column 3, lines 28-29).

**Claim 28:**

Valencia, as shown, discloses the following limitation:

- *reducing the benefits for which the customer is eligible by the amount of the electronic coupon* (see at least column 3, lines 28-29).

**Claim Rejections - 35 USC § 103**

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claims 6, 13, 20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valencia et al. (US 5,380,991) in view of Iannacci (US 2002/0062249 A1).

**Claim 6 and 27:**

Valencia discloses the limitations as shown in the rejections above. Furthermore Valencia, as shown, discloses the following limitation:

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- *discovering the benefits available to the customer includes using the identity of the customer to discover the benefits from the identity of the customer (see at least column 3, line 16).*

Valencia does not disclose the following limitation, however, Iannacci, as shown, does:

- *using the identity of the customer to discover the benefits from the identity of the customer and an online service (see at least ¶ 0118, “it provides identity management and authentication service” and ¶0119, “using wired and wireless mediums (e.g., the Internet...)”).*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the additional functionality of an online service to the invention of Valencia because such an improvement “provides an on-line, interactive, and fully integrated program... and executes functions to produce and acquire the maximum or preferred benefit items for users...” (Iannacci, ¶0104).

**Claim 13:**

Valencia does not disclose the following limitations, however, Iannacci, as shown, does:

- *the benefit source includes an online service (¶0119, “using wired and wireless mediums (e.g., the Internet...)”).*
- *discover, from the identity of the customer and the online service, the benefits available to the customer (see at least ¶ 0118, “it provides identity management and authentication service” and ¶0119, “using wired and wireless mediums (e.g., the Internet...)”).*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the additional functionality of an online service to the invention of Valencia because such an improvement “provides an on-line, interactive, and fully integrated program... and executes functions to produce and acquire the maximum or preferred benefit items for users...” (Iannacci, ¶0104).

**Claim 20:**

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Valencia discloses the limitation as shown in the rejections above. Furthermore Valencia, as shown, discloses the following limitations:

- *discovering, from the benefit source, the benefits available to the customer* (see at least column 3, line 16).

Valencia does not disclose the following limitations, however, Iannacci, as shown, does:

- *the benefit source includes an online service* (¶0119, “using wired and wireless mediums (e.g., the Internet...)”),
- *discovering, from the identity of the customer and the online service, the benefits available to the customer* (see at least ¶ 0118, “it provides identity management and authentication service” and ¶0119, “using wired and wireless mediums (e.g., the Internet...)”).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the additional functionality of an online service to the invention of Valencia because such an improvement “provides an on-line, interactive, and fully integrated program... and executes functions to produce and acquire the maximum or preferred benefit items for users...” (Iannacci, ¶0104).

### **Double Patenting**

- 19.** Applicant is advised that should claims 8-14 be found allowable, claims 15-21 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

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### **Conclusion**

- 20.** Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A Reagan** can be reached at **571.272.6710**.
- 21.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
- 22.** Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to **571-273-8300**.

- 23.** Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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20 November 2007  
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